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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,092	03/11/2004	Sabine Oepen	50817-02	4576

26474 7590 05/03/2006

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EXAMINER

FIGUEROA, JOHN J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/797,092	Applicant(s) OEPEN ET AL.	
	Examiner John J. Figueroa	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/11/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Number 3,919,157 to Ide et al. (hereinafter 'Ide').

Ide discloses a thermoplastic impact resistant composition having high transparency, strength, surface hardness and toughness; said composition comprising a resin (I) that contains a copolymer of styrene, acrylonitrile and methyl-methacrylate and a graft component that can include a styrene-butadiene rubber, styrene and/or a copolymer of styrene and acrylonitrile, and (II) an organopolysiloxane. (See Abstract; col. 1, lines 46-68; col. 2, lines 1-59; col. 3, lines 1-25; col. 23, lines 10-37)

In Examples 1-3, Ide discloses a resin composition comprising a graft copolymer latex containing a butadiene/styrene rubber and an acrylonitrile-styrene copolymer, an acrylonitrile-styrene-methacrylate terpolymer and polydimethylsiloxane. In Example 22 (referring back to 3) 0.05 parts of polydimethylsiloxane were employed in the composition. (Col. 15, lines 40-43). In Example 1, the amount of the graft-copolymer latex is 100 parts and the amount of the terpolymer latex is 400 parts, giving a total of

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500 parts which is an amount, in parts polyorganosiloxane, that would fall within the range recited in claim 10 of 10-190 ppm of polyorganosiloxane added.

On tables 1-5, Ide discloses data showing total luminous transmittance and impact strength properties resulting from adding the resin composition to a metal mold. Ide further discloses examples of adding organosiloxanes of various viscosities, ranging from about 3 to 30 centistokes, and that the results from the examples clearly demonstrate that the organosiloxane enhances the impact strength of the resulting resin composition. (Examples 22-28 on col. 15-16; Table 5, col. 17, lines 23-34)

Ide does not specifically mention the Cold Stress Whitening properties of the molding compositions. However, the ability of the polysiloxane to reduce undesirable changes in shade is an inherent property of the polysiloxane. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his or her claimed product. Whether the rejection is based on inherency under 35 U.S.C. 102, on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...footnote omitted." The burden of proof is similar to that required with respect to product-by-process claims. In *re Fitzgerald*, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). Also, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. In *re May*, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978).

Thus, the claims are anticipated by Ide.

Conclusion

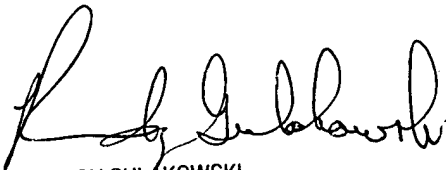
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJF/RAG


RANDY GULAKOWSKI
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